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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,380	02/02/2000	Geoffrey B. Rhoads	60102	6129

23735 7590 10/05/2004

DIGIMARC CORPORATION
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BEAVERTON, OR 97008

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/496,380

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/2/22.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) 5, 8, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 are pending in this application and have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the term: "substantially inaudible." The term is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 2-11 are dependent on claim 1 and are thereby rejected on the same basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, and 7, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Moses et al. 4,425,642.

As for claim 1, Moses teaches a detection system for detecting an embedded data signal within an audio signal (abstract), notwithstanding temporal imperfections in the audio signal that change it's pitch (col. 5 lines 50-55), the embedded data signal being substantially inaudible to a listener (col. 1 lines 40-47), the system characterized by plural detectors receiving the same input (col. 6 lines (8-16) signal, the first of said detectors being operable to sense the embedded signals if the audio signal has a first temporal imperfection leading to a first change in pitch, and a second of said detectors being operable to sense the embedded signal if the audio signal has a second temporal imperfection leading to a second, different change in pitch (col. 6 lines 60-65).

As for claim 2, Moses teaches plural detectors arranged in parallel (fig. 4b)

As for claim 3, Moses teaches plural detectors implemented in hardware circuitry (fig. 4b).

As for claim 7, Moses teaches that the temporal imperfections may arise from variations in playback speed (col. 6 lines 60-65).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moses and Official Notice taken as detailed below.

As for claim 4, Moses does not explicitly teach the detector circuit as implemented on a single integrated circuit. However Official Notice may be taken that such a step is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Moses. It would have been desirable to do so as this would allow for easier component installation.

As for claims 6 and 9, Moses does not teach that the embedded data is used to signal that copying of the audio should be limited, or to identify the media. However Official Notice may be taken that the use of embedded data for that purpose is a step that is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Moses. It would have been desirable to do so as this would allow for wider use and marketability for the system.

Allowable Subject Matter

8. Claims 5, 8, 10, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems of data hiding and detection similar to the applicant's:

Stebbings 6,684,199

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Hannigan et al. 6,674,876

Linnartz et al. 6,515,040

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

9/28/04

-Paul Callahan